

Appl. No. 10/054,628
Docket No. 7571RD
Arndt. dated September 18, 2006
Reply to Office Action mailed on June 16, 2006
Customer No. 27752

REMARKS

Applicants thank Examiner for consideration given to the present application. Claims 1-11 are pending. No claims have been added or amended in this Reply.

Rejection Under 35 U.S.C. 103(a)

The pending claims have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,609,587 (herein, "Roe") in view of U.S. Patent No. 4,661,105 (herein, "Gale"). Applicants respectfully traverse this rejection.

THE ARGUMENT

The PTO failed to construct a prima facie case of obviousness. "During patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability. ... If the PTO fails to meet this burden, then the applicant is entitled to a patent." *In re Glaug*, 283 F.3d 1335, 1338, 62 YSOQ2d 1151, 1152-53 (Fed. Cir. 2002). To establish a prima facie case of obviousness under 35 U.S.C. §103, the PTO must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. See, for example, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

A. SUGGESTION OR MOTIVATION TO COMBINE THE REFERENCES

1. There was no suggestion to Combine *Roe* and *Gale*.

Applicants respectfully assert that *Roe* and *Gale* cannot be properly combined to support a rejection under 35 U.S.C. §103 because one of ordinary skill in the art would not be motivated to combine them. The mere fact that references can be combined or modified does not render the resultant combination of obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. ... However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. ... Rather, to establish obviousness

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based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 217 F.3d 1369, 55 USPQ2d 1316 (Fed. Cir. 2000).

The Office Action states that the pending claims are unpatentable over *Roe* in light of *Gale* because "*Roe* teaches [that] cellulose derivatives are used as stabilizers" and *Gale* "shows that cellulosic agents are equivalent to the claimed materials as rheological agents". However, there are many important differences between *Gale* and *Roe*. First, *Gale* adds a rheological agent to a drug (herein, "composition") to ensure that the drug may be controllably released over time (Col. 1, lines 16-17; Col 1, lines 66 and 67, and Col. 2, lines 1-16), while *Roe*'s lotion is not time released, but is meant to provide an immediate protective layer to a wearer's buttocks and anal region (Col. 2, lines 52-53). Second, prior to use, *Gale*'s composition is sealed from exposure (Col. 3, lines 34-35), while *Roe*'s lotion is not (Col. 2, lines 60-61). Third, *Gale*'s composition is contained within a compartment as a reservoir, floating between hydrophobic layers (Col. 3, lines 32-34), while *Roe*'s lotion is applied to the outer surface of a hydrophilic topsheet (Col. 10, lines 23 and 33). Thus, because *Gale*'s and *Roe*'s delivery systems are completely different, the type of composition each needs is completely different. For these reasons, there would be no motivation or suggestion for one of ordinary skill in the art to combine *Roe* and *Gale*.

2. *Gale* teaches away from *Roe*'s claimed invention.

Applicants respectfully assert that *Gale* cannot be used to support a rejection under 35 U.S.C. §103 because it teaches away from *Roe*'s claimed invention. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983).

Roe states that their composition becomes solid or semi-solid such that it remains locked in on the skin-contacting surface of the absorbent article. Col. 9, lines 57-65; Col. 18, lines 30-31; Claim 1. However, *Gale* teaches that its composition must remain fluid to flow through its rate controlling membrane. Col. 3, lines 58-65. The amount of fluid present in *Gale*'s composition is from about 10-90 wt %. Col. 5, lines 42-43. Thus, *Gale* teaches away from the idea of formulating a composition that becomes solid or semi-

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solid. For these reasons, it would not be obvious for one of ordinary skill in the art to combine *Gale* with other references in order to achieve *Roe*'s claimed invention.

3. *Gale* is nonanalogous art.

Applicants respectfully assert that *Gale* cannot be properly combined to support a rejection under 35 U.S.C. §103 because it is not in the field of Applicants' claimed invention, nor does it speak to the problem(s) that Applicants address. "The determination that a reference is from a nonanalogous art is ...twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." *In re Wood*, 599 F.2d 1032, 202 U.S.P.Q.171 (C.C.P.A. 1979).

Gale discloses the use of cellulosic agents used for their thixotropic and thickening properties, particularly for use in a drug delivery systems. Col. 5, lines 45-46; Col. 1, lines 14-17. Applicants, however, claim rheological agents as part of a skin care composition. Thus, *Gale*'s control released drug delivery system is not in the same field as Applicants' skin protectant. Further, and more particularly, *Gale* adjusts the viscosity of its composition to achieve controlled release (Col. 5, lines 46-53), while Applicants' use rheologic agents to suspend skin care ingredients (Page 6, lines 1-4). Thus, *Gale* addresses a much different problem or challenge than Applicants. For these reasons, *Gale* is nonanalogous art.

B. Reasonable expectation of success

Applicants respectfully assert that *Gale* cannot be properly used to support a rejection under 35 U.S.C. §103 because it would not have been obvious for one of ordinary skill in the art to use chemical agents disclosed by *Gale* to solve the problems faced by *Roe*.

One cannot base obviousness upon what a person skilled in the art might try or might find obvious to try, but rather must consider what the prior art would have led a person skilled in the art to do. *In re Tomlinson*, 150 USPQ 626 (CCPA 1966). For instance, In *In re Goodwin* (herein "Goodwin"), 576 F.2d 375, 198 USPQ 1 (CCPA 1978), the invention related to a glass mold lubricant and a method of coating a glass mold cavity with a carbon monofluoride at a temperature in range of 1000 degrees

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Celsius. The prior art taught that carbon monofluorides were useful as cell lubricants and were stable at oxidizing atmospheres at temperatures of up to 800 degrees Celsius. The USPTO took the position that it would have been obvious to one of ordinary skill in the art to use carbon monofluorides as mold lubricants. However, while the Court recognized that the prior art taught the use of the claimed compounds as lubricants, said use was at temperatures significantly below the temperature range specified by applicant. Thus, the Court held that a person of ordinary skill in the art might have tried to use carbon monofluoride as a mold lubricant but the prior art did not suggest that he do so.

As *Goodwin* generally teaches use of carbon monofluoride carbons as lubricants, *Gale* generally teaches the use of cellulosic agents as rheologic agents. Col. 5, lines 61-64. More particularly, *Gale* teaches the use of cellulosic agents in compositions having greatly different formulas, flow dynamics, and overall utility than *Roe*'s invention. Thus, like the use of carbon monofluorides for lubrication at different temperatures was not obvious in *Goodwin*, the use of thickening agents for a greatly different composition having greatly different flow dynamics should not be considered obvious in the present case.

Further, it must be said that there is usually an element of "obvious to try" in any research endeavor. However, the chemical arts are unpredictable. It normally takes thousands or millions of formula variations before arriving at the desired improvement. Thus, "obvious to try" certainly cannot stand as a test. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

C. REFERENCES MUST TEACH OR SUGGEST ALL THE CLAIM LIMITATIONS.

Finally, Applicants respectfully assert that *Roe* and *Gale* cannot be properly combined to support a rejection under 35 U.S.C. §103, and thus all of Applicants' claimed limitations are not taught or suggested.

However, assuming, *arguendo*, that *Roe* and *Gale* could be properly combined, all of the claimed limitations would still not be taught. The Office Action states that "Roe teaches the cellulose derivatives are used as stabilizers", and that *Gale* "shows that cellulosic agents are equivalent to the claimed rheological agents". However, Applicants' assert that the claim of the present application is not as broad as "rheological agents" or as broad as "cellulosic" rheologic agents, but rather, the claim is limited to particular amounts of particular rheological agents.

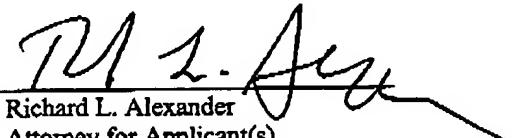
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Thus, using *Gale* to show that cellulosic agents are equivalent to rheologic agents, as the Office Action argues, does not teach the particular rheologic agents or the particular amounts claimed by Applicant. For these reasons, all of the claim limitations are not taught.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. 103(a). In view of the foregoing, Applicants respectfully request reconsideration of this application and allowance of the pending claims.

Respectfully submitted,
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